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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,604	02/14/2001	Usha Goswami	056859-0117	9775

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EXAMINER

SAKELARIS, SALLY A

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 02/04/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/782,604

Applicant(s)

GOSWAMI ET AL.

Examiner

Sally A Sakelaris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-107 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-107 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-73, 78-107 drawn to a method for development of nucleotide probes for myctophid fishes, classified in Class 435, subclass 6, 69.1, 91.2, 252.3, and 320.1, Class 536, subclass 23.5, 24.31 and 24.33
  - II. Claim 74 is drawn to a nucleotide base sequence of, PSL CYTL classified in class 435, subclass 6.
  - III. Claim 75 is drawn to a nucleotide base sequence of, PSL ITS2F classified in class 435, subclass 6.
  - IV. Claim 76 is drawn to a nucleotide base sequence of, PSL PROL classified in class 435, subclass 6.
  - V. Claim 77 is drawn to a nucleotide base sequence of, ROD PSL SLMB classified in class 435, subclass 6.
1. a. Inventions I and II, and I and III, I and IV, and I and V are related as products and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case each of the polynucleotides of inventions II-V can be used in a materially different process such as for developing a computer readable format.

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b. Inventions II-V are patentably distinct in structure and physiochemical properties. Invention II is drawn to a nucleotide base sequence of, PSL CYTL, Invention III to a nucleotide base sequence of, PSL ITS2F, Invention IV to a nucleotide base sequence of, PSL PROL, and Invention V to a nucleotide base sequence of, ROD PSL SLMB. Because these nucleic acids are composed of different nucleotides linked by phosphodiester bonds in a varied order and arranged in space as a double helix in a vary different configuration, their resulting structure and function are drastically divergent and therefore are patentably distinct. Therefore, the inventions of groups I and II are patentably distinct from each other.

**Restriction Requirement Applicable to All Groups:**

2. Each sequence is patentably distinct because they are unrelated sequences, i.e. these sequences are unrelated because the protein encoded by these sequences differs in structure, function and in biological activity. A restriction is applied to each Group. Applicant is required to elect:
- a). A single myctophid fish species(claim 2),
  - b). A single gene region(mitochondrial **or** nuclear: claim 3),
  - c). A single gene for probe preparation(claims 4-8),
  - d). A single gene for amplification(Claims 20-27),
  - e). A single primer or primer pair(claims 9-19) for amplifying the same single gene that corresponds to a). to d).
  - f). A single primer or primer pair for cycle sequencing(claims 28-41) for the same gene elected in a). to e). above.
  - g). The same embodiment chosen above for method claims (claims 42-73)

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h). A single, species-specific, primer or primer pair(claims 78-107)

\*Elections for a). to h). Must all correspond to the amplification of the same, single, elected gene.

All of the above must correspond to the same elected group(See MPEP 803.04).

For example, if applicant elects Group I and then they further elect, from the nuclear gene region, the Rod gene, Claims 1-3, 5, 6, 8, 14, 17, 28, 36, 37, 45, 51, 57, 60-66, 70, 77, 84, 85 will be examined to the extent that they apply to the elected "Rod" embodiment.

Primers and probes comprising different nucleotide sequences are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq. Furthermore, each embodiment of Group I is drawn to patentably distinct methods that, include different reagents and have different objectives. Each specific gene assay represents a different, species-specific approach to a quantitative assay and DNA detection. The phylogenic distance between each of the species comprising these embodiments is vast and as a result, much dissimilarity is present between for example, the *Stenobrachis leucopsarus* and *Lampanyctus regalis*. Each species has a specific nucleic acid composition of successive nucleotides linked in phosphodiester bonds and arranged in space as a double helix. Because each embodiment is comprised of nucleotides in a myriad arrangement of base pairs wherein this arrangement and surrounding environment can dictate various secondary structures and innumerable different resulting properties, characteristic to each individual nucleic acid molecule

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and the species from which it comes, the methods all have very different steps, objectives and reagents. Therefore the methods are distinct over one another.

3. Applicant is advised that examination will be restricted to only the elected SEQ ID NOS: and gene names and should not be construed as a species election.

Claims 1-5, 8, 28, and 60-66 link the inventions of Groups I-V. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 1-5, 8, 28, and 60-66. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

4. Applicant is advised that the reply to this requirement, to be complete, must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR

1.48(b) and by the fee required under 37 CFR 1.17(i).

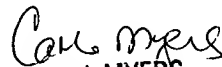
Any inquiry concerning this communication or earlier communication from the examiner should be directed to Sally Sakelaris whose telephone number is (703) 306-0284. The examiner can normally be reached on Monday-Thursday from 7:30AM-5:00PM and Friday from 1:00PM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W.Gary Jones, can be reached on (703)308-1152. The fax number for the Technology Center is (703)305-3014 or (703)305-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to Chantae Dessau whose telephone number is (703)605-1237.

Sally Sakelaris

  
1/31/2003

  
CARLA J. MYERS  
PRIMARY EXAMINER